

REMARKS

Reconsideration and allowance of the present patent Application based on the following remarks are respectfully requested.

By this Amendment, claims 1 and 16 are amended to correct minor clerical errors. No new matter has been added. After entry of this Amendment, claims 1-16 will remain pending in the patent application.

Applicant appreciates the indication by the Examiner that claims 3-6 and 12-15 contain patentable subject matter. However, Applicant delays rewriting these claims in independent form so that the Office may reconsider the allowability of the base claims based on the following remarks.

Claims 1-2, 8-9 and 10-11 were rejected under 35 U.S.C. §103(a) based on Turina (U.S. Pat. No. 6,031, 832). The rejection is respectfully traversed.

Claim 1 recites a method comprising, *inter alia*, controlling the telecommunication system load by adjusting the capacity of the channel used for relaying the channel allocation requests. As conceded by the Examiner on page 3 of the Office Action, Turina fails to teach or suggest this feature. The Examiner, however, alleges that it would have been obvious to one of ordinary skill in the art to employ in the system of Turina a mechanism in which the channel capacity of the PRACH can be adjusted. Applicant disagrees and submits that there is no motivation or suggestion in Turina to provide such a feature.

In addition, Applicant respectfully points out that the Examiner has cited to no reference or teaching that would motivate one skilled in the art to modify Turina so that system load is controlled by adjusting the capacity of the channel used for relaying the channel allocation requests.

MPEP §2141 also states “When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impressive hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined.”

MPEP §2141.02 states “Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.” MPEP §2141.02 further states “In determining the

differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” (Emphasis in original.)

In that regard, Applicant notes that it is improper to propose a modification that would render a reference unsatisfactory for its intended purpose. See MPEP §2145. One of the intended purposes in Turina is to have the network handle on the uplink (*i.e.*, from the mobile station to the base station) all the random access requests for channel allocation. Thus, Turina discloses that the network must receive the random access request message sent by the mobile station. (See col. 3, lines 5-7). Turina also discloses that a channel is reserved for uncontended access by uplink packet traffic and that the VIP mobile station always has a specified bandwidth for uplink and downlink. (See claim 1 and col. 5, lines 17-20). This system differs from the telecommunication system of claim 1, where the capacity of the uplink channel used for relaying channel allocations requests can be adjusted. Clearly, the intended purpose of having all the random access requests handled by the network and to have uncontended access by uplink traffic would be defeated if a system was implemented in Turina to vary the number of access requests.

In addition, Applicant submits that Turina clearly teaches away from the invention of claim 1. Turina specifically discloses that the VIP mobile station (VIP MB) is given the highest priority to access physical channels by allocating a reserved random access channel dedicated to the VIP MS. (See col. 4, lines 5-16). Turina discloses that, in doing so, the numerous and variable random delays experienced by prior mobile stations no longer exist. Id. However, since the VIP MS according to Turina has a random access channel of its own, there can be no motivation or suggestion whatsoever to adjust the capacity of the random access channel, as recited in claim 1.

Therefore, for at least these reasons, Applicant submits that by citing Turina alone, the Examiner has not set forth a proper rejection under 35 U.S.C. §103(a) to maintain that claim 1 is obvious.

Claims 2 and 8-9 are patentable by virtue of their dependency from claim 1 and for the additional features recited therein. Moreover, with respect to the allegation on page 4, lines 5-6, that the methods of claim 8 is an inherent teaching of Turina (base station 14 in FIG. 1), it is respectfully noted that the Examiner has provided no basis in fact and/or technical reasoning as to why these teachings necessarily flow from Turina, as required by MPEP §2112. The Examiner is respectfully requested to provide the required basis in fact and/or technical reasoning or withdraw the rejection.

Claim 10 is patentable for at least the same reasons provided above related to claim 1 and for the additional features recited therein. Namely, claim 10 is patentable over Turina at least because this claim recites a telecommunication system comprising, *inter alia*, a telecommunication connection including a channel for relaying channel allocation requests transmitted by the subscriber terminal to the network part, wherein the telecommunication system is arranged to control the load by adjusting the capacity of the channel used for relaying the channel allocation requests. As mentioned previously, by citing Turina, the Examiner has not set forth a proper rejection by relying on a reference that fails to teach or suggest all of the features of claim 10.

Claim 11 is patentable by virtue of its dependency from claim 10 and for the additional features recited therein.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-2, 8-9 and 10-11 under 35 U.S.C. §103(a) based on Turina are respectfully requested.

Claims 7 and 16 were rejected under 35 U.S.C. §103(a) based on Turina in view of Hjelm et al. (U.S. Pat. No. 6,529,497) (“Hjelm”). The rejection is respectfully traversed.

Claim 7 depends from claim 1 and is patentable over Turina for at least the same reasons provided above related to claim 1. Namely, claim 7 is patentable over Turina at least because this claim recites a method comprising, *inter alia*, controlling the telecommunication system load by adjusting the capacity of the channel used for relaying the channel allocation requests.

Hjelm fails to overcome the deficiency of Turina. As mentioned in Applicant’s August 7, 2003, response, Hjelm fails to teach or suggest such a feature. Therefore, any reasonable combination of Turina and Hjelm does not, in any way, result in the invention of claim 7.

Similarly, claim 16 depends from claim 10 and is patentable over Turina for at least the same reasons provided above related to claim 10. Namely, claim 16 is patentable over Turina at least because this claim recites a telecommunication system comprising, *inter alia*, a telecommunication connection including a channel for relaying channel allocation requests transmitted by the subscriber terminal to the network part, wherein the telecommunication system is arranged to control the load by adjusting the capacity of the channel used for relaying the channel allocation requests.

Hjelm fails to overcome the deficiency of Turina. As mentioned in Applicant’s August 7, 2003, response, Hjelm fails to teach or suggest such a feature. Therefore, any

reasonable combination of Turina and Hjelm does not, in any way, result in the invention of claim 16.

Accordingly, reconsideration and withdrawal of the rejection of claims 7 and 16 under 35 U.S.C. §103(a) based on Turina in view of Hjelm are respectfully requested.

The rejections having been addressed, Applicant requests issuance of a notice of allowance indicating the allowability of all pending claims. If anything further is necessary to place the application in condition for allowance, Applicant requests that the Examiner contact Applicant's undersigned representative at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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